a one-month extension if time to file this amendment and the requisite authorization for payment of the necessary fee.

Applicants thank the Examiner for her phone conversations following the mailing of the final Office Action. The amendments to Claim 1 presented above were not presented earlier on account of the fact that it was not until the undersigned had phone communication with the Examiner after the final Office Action that the Applicants realized that the Examiner was interpreting the term "wet cake" as used in the claims so broadly as to include filter cake which may or may not be comprised of water. Thus, this amendment is presented to make clear that the claims are intended to pertain to wet cake which is comprised of water in addition to the other identified component(s). Support for this amendment can be found in the Specification at least at paragraphs 43 and 44.

Claims 1-4 feature a wet cake that is comprised of water and solid brominated diphenylethane product. As is recited in paragraphs 42 - 44 of Applicants' specification, such wet cakes are derived from a water and solids slurry. It is this wet cake that has the low occluded free bromine content (about 500 to about 2000 ppm) that is a feature of the invention.

The prior art is silent in regards to such a water wet cake and is totally vacuous in teaching the preparation of same.

Mack et al ('248), cited in support of the Examiner's rejection of original claims 1-4, does not teach a water containing wet cake having an occluded free bromine content of about 500 to about 2000 ppm or a process for its manufacture. This is not to say that Mack et al does not contain any teachings in regard to wet cakes. Indeed, Mack et al describes two separate and very different kinds of wet cakes. The first, is a wet cake from a water slurry. The second, is a wet cake, not from a water slurry, but rather, from recrystallization of brominated diphenylethane from an aromatic solvent. Thus, the water wet cake is the only Mack et al wet cake pertinent to Applicants' amended claims.

Mack et al discusses the wet cake from the water slurry in col. 5, lines 31 – 37; Example 1, lines 37 – 42; Examples 2 – 4, lines 10 – 12; Example 5, lines 6 – 11; and Example 8, lines 49 – 52.

It is important to note that Mack et al does not mention the occluded free bromine content of the water wet cake or the desirability of such or how such would be obtained.

In rejecting original claims 1 – 4, the Examiner has stated that,

> "Based on the products of the prior art having low YI and identical components as recited by the instant invention, the ordinary artisan in the art would have the reasonable expectation that the occluded bromine content of these products would also be similar to that of the claimed invention."

Further, in making the rejection the Examiner asked for evidence that the products of the prior art do not have similar occluded bromine content.

The Examiner's comments regarding the expectations of the skilled artisan do not apply to a water wet cake since Mack et al. ('248) does not disclose a water wet cake having the low YI's necessary to form the basis for the artisan's expectations. The Examiner's comments in regard to the YI, can only be related to the wet cake obtained from the aromatic solvent and recrystallized solids slurry.

Since there is no express teaching in Mack et al. ('248) regarding occluded free bromine content of a water-containing wet cake, the only way Mack et al. ('248) could be relied upon is through its alleged inherent disclosure. Even under 35 U.S.C. § 102, however, a showing of inherency requires that the reference be such that the allegedly inherent feature is *necessarily* present and that such presence *would be recognized by a person of ordinary skill in the art. Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1377, 62 USPQ2d 1917, _____ (Fed Cir. 2002) (*citing, inter alia, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Inherency cannot "be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* (*quoting In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). In the obviousness context of 35 U.S.C. § 103, the courts time and time again have said that obviousness cannot be predicated upon that which is unknown. See, e.g., *In re Gracelli*, 713 F.2d 731, 739, 218 USPQ 769, ____ (Fed. Cir. 1983). No inherent disclosure can be supported by the Mack et al. ('248) reference. It cannot be shown how one of ordinary skill in the art could recognize a level of occluded free bromine in the water wet cakes of Mack et al. ('248), much less that such levels are *necessarily* present. In short, there is no disclosure in Mack et al. ('248) which might support a *prima facie* case of obviousness.

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The Examiner's second line of argument concerns a lack of comparative evidence. Such evidence is only required once a *prima facie* case of obviousness has been made. For the amended claims, no prima facie case has been or can be made. Thus, there is no need for a comparative showing.

Please continue to address correspondence in this application to Mr. Pippenger of Albemarle Corporation at the address of record. Entry of this amendment and favorable action upon the remaining amended claims is solicited.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this document, and any attachments referenced herein and attached hereto, are being transmitted on the date indicated below to the U. S. Patent and Trademark Office by facsimile number : 1-703-872-9307, in accordance with 37 C.F.R. § 1.6(d).

Sept. 4, 2002
Date

R. Andrew Patty II

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VERSION OF PROPOSED AMENDED CLAIMS SHOWING CHANGES MADE

Claim Amendment:

1. A wet cake comprising water and solid brominated diphenylethane product, which product contains [containing] a predominate amount of decabromodiphenylethane, the wet cake [and] having an occluded free bromine content of from about 500 ppm to about 2000 ppm.